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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,328	02/05/2004	Hiromi Tabuchi	1131-0500P	4066
2252	7590	07/17/2009		
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747		EXAMINER KEMMERLE III, RUSSELL J		
		ART UNIT 1791		PAPER NUMBER
NOTIFICATION DATE		DELIVERY MODE 07/17/2009 ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/771,328	<b>Applicant(s)</b> TABUCHI ET AL.
	<b>Examiner</b> RUSSELL J. KEMMERLE III	<b>Art Unit</b> 1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 11 June 2009.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1,2,4 and 6-13 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,2,4 and 6-13 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-166/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11 June 2009 has been entered.

#### ***Claim Rejections - 35 USC § 103***

Claims 1, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noe (US Patent 5,494,055) in view of Miyauchi (US Published Application 2002/0,074,007) and Le Gars (US Patent 5,143,099).

Noe teaches a rod shaped filler including tobacco, an inner wrapper surrounding the rod shaped filler, an outer wrapper surrounding the inner wrapper, and a perfume layer in between the inner and outer wrapper that weakens the odor of the sidestream smoke (claim 1). Noe further discloses covering the entire surface of the inner wrapper with the perfume material (Col 4 lines 30-40). Noe discloses that the perfume material be a microcapsule which is considered to be a grain or powder (Col 4 lines 40-50). Noe specifically discloses that the perfume material be applied to the cigarette rod covering (inner wrapper) (claim 11).

Noe does not expressly teach that the perfume emitting layer contain a glue for carrying the perfume material.

Miyauchi discloses a method of improving the smell of a sidestream smoke of tobacco, where a perfume material is used to improve the smell, and a polyvinyl acetate glue may be used as the carrier for the perfume material (abstract). Miyauchi further discloses that an adhesive be applied as seam adhesive to keep the outer wrapper sealed (page 3, paragraph 29).

It would have been obvious to one of ordinary skill in the art, at the time of invention by applicant, to have modified the method taught by Noe of forming a cigarette by using the method taught by Miyauchi of using polyvinyl acetate glue as the carrier for the perfume material. This would have been obvious because Miyauchi discloses that such glue is helpful in adhering a perfume material to a cigarette wrapper.

Le Gars discloses a double wrapped cigarette which results in less spotting, and specifically recommends that the inner wrapper have a width corresponding exactly to the cigarette circumference, so that there is no overlap (Col 2 lines 59-66).

Thus, it would have been further obvious to one of ordinary skill in the art, at the time of invention by applicant, to have modified the cigarette of Noe and Miyauchi as discussed above by using an inner wrapper which corresponds exactly to the circumference of the cigarette and has no overlap when formed. This would have been obvious because Le Gars discloses this as a way of reducing the spotting on a cigarette.

Referring to claim 11, Miyauchi discloses that the glue used to carry the perfume material is the same as seam glue used (page 3, paragraph 29).

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Noe in view of Miyauchi, Le Gars and Baker (US Patent 4,624,268)

Noe Miyauchi and Le Gars are relied upon as discussed above, but do not expressly teach the use of an additive for reducing the sidestream smoke.

Baker teaches that sidestream smoke may be reduced by the use of chemicals added to the cigarette paper (abstract).

It would have been obvious to one of ordinary skill in the art, at the time of invention by applicant, to have modified the invention taught by Noe in view of Miyauchi as discussed above, by adding the sidestream smoke reducing chemicals of Baker to the cigarette paper. This would have been obvious in order to achieve the desired result of reduced sidestream smoke.

Claims 6-8, 10, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noe in view of Miyauchi, Le Gars and Lowman (US Patent 2,999,520)

Referring to claim 6, Noe teaches a machine for manufacturing double wrapper cigarettes having a first and second path for inner and outer wrappers, a wrapping section, a perfume supply device supplying perfume to one of the webs between the webs to weaken the odor of sidestream smoke, and covering the entire inner surface of the inner wrapper (Col 4 lines 10-50).

Noe does not specifically disclose a glue for carrying the perfume material, or a cutting section for cutting sections of a predetermined length.

Miyauchi discloses polyvinyl acetate glue as a good carrier of perfume materials (abstract).

Lowman teaches a cigarette machine that involves a cutter for creating sections of a predetermined length (Col 2 lines 50-53).

It would have been obvious to one of ordinary skill in the art, at the time of invention by applicant, to modify the manufacturing machine of Noe by further incorporating the glue of Miyauchi to carry the perfume material. This would have been obvious because Miyauchi discloses that the use of such a glue as a carrier for a perfume material is effective in reducing sidestream smoke. It would have been further obvious to use a cutter such as the one taught by Lowman since such a device is necessary for processing cigarettes into the desired size.

Referring to claims 7 and 8, Noe further discloses applying glue and spraying (diffusing) (Col 4 lines 10-50), which would require the use of a nozzle.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Noe in view of Miyauchi, Lowman, Le Gars, Marchese (US Patent 2,320,702) and Eckstein (US Published Application 2001/0,009,938).

Noe, Miyauchi, Lowman and Le Gars are relied upon as discussed above, but fail to specifically teach using brush rollers to apply the perfume material and to remove any excess from the web.

Eckstein teaches that brush coating is customary in the paper industry (paragraph 110).

Marchese teaches the removal of a surplus material from a carrier using a brush roller (Page 2, Col 2 lines 48-52).

It would have been obvious to one of ordinary skill in the art, at the time of invention by applicant, to modify the method taught by Noe, Miyauchi and Lowman as discussed above, by using a brush to coat the perfume material onto the web, and to then later use a brush roller to remove any excess perfume material as taught by Eckstein and Marchese, respectively. This would have been obvious because these are taught to effective means of getting a desired quantity and quality of a coating material on a carrier.

#### ***Response to Arguments***

Applicant's arguments filed 11 June 2009 have been fully considered but they are not persuasive.

Applicant's first argue that the perfume material of the present invention is carried by the carrier glue, while Miyauchi's flavorant is carried by the seam glue, and as such, Miyauchi is unable to carry a large amount of flavorant.

It is first noted in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231

USPQ 375 (Fed. Cir. 1986). Thus, applicants' argument solely against Miyauchi while ignoring the teachings of the other references is not found to be persuasive.

When the total teachings of the prior art is considered, one skilled in the art would find it obvious to coat the entire inner wrapper with a perfume material (as taught by Noe) and to hold the perfume material in place with an adhesive material (as taught by Miyauchi).

Further, applicants argument the Miyauchi is unable to carry a large amount of flavorant is found to be unpersuasive since no specific amount of flavorant is required by the current claims, so this is not a deficiency of Miyauchi.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RUSSELL J. KEMMERLE III whose telephone number is (571)272-6509. The examiner can normally be reached on Monday through Thursday, 7:00-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason L Lazorcik/  
Examiner, Art Unit 1791

/R. J. K./  
Examiner, Art Unit 1791